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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/553,546	09/12/2006	Patrick Hanley	PA1365	4055

28390 7590 02/12/2009

MEDTRONIC VASCULAR, INC.
IP LEGAL DEPARTMENT
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EXAMINER	
PEZZUTO, HELEN LEE	
ART UNIT	PAPER NUMBER
1796	

NOTIFICATION DATE	DELIVERY MODE
02/12/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

rs.vasciplegal@medtronic.com

Office Action Summary	Application No.	Applicant(s)	
	10/553,546	HANLEY ET AL.	
	Examiner	Art Unit	
	Helen L. Pezzuto	1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *05 January 2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *15-28* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *15-28* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/5/09 has been entered.

Response to Amendment

Applicant’s amendment to claims 15 and 26 filed in the response on 1/5/09 is acknowledged. Currently, claims 15-28 are pending in this application.

Claim Rejections - 35 USC § 112

2. Claims 15 and 26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In reference to applicant’s paragraphs [0047] and [0065], while there is support for the “with only one curing

step" recited in the amended claims 15 and 26, there is no support for the recited "at room temperature". In paragraph [0065], the only requirement within the UV chamber is a UV source operating at 365nm. There is not requirement that heating elements are barred in the chamber and that the curing step is performed at room temperature. Hence, the recited "at room temperature" constitutes new matter.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 15-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garnett et al. (US-511) for the reasons of record.

US 6,162,511 to Garnett et al. discloses a radiation curable coating composition comprising a resin component including an unsaturated monomer, and an unsaturated oligomer/prepolymer, and binder or mixture thereof (see abstract). Suitable substrate material includes plastics

and metals, which fall within the scope of the instant biomedical device (col. 7, lines 63-67). Specifically, suitable unsaturated monomers include unsaturated carboxylic acid (e.g. acrylic acid), and multifunctional acrylate within the scope of claim 2 (col. 2, lines 34-54). Prior art oligomer or prepolymer falls within the scope of the instant relatively low molecular weight polymer. Suitable higher molecular weight binder polymer includes polyvinylpyrrolidone, encompassing the instant higher molecular weight polymer expressed in claim 14 (col. 3, lines 4-16). Hydrogen abstracting photoinitiator such as benzophenone and reaction solvent were also taught (col. 3, lines 38-39; col. 4, lines 22-24). Accordingly, one having ordinary skill in the art would have readily envisage selecting the claimed components in the forming a coating composition suitable for coating on an implantable biomedical device, motivated by the reasonable expectation of success.

6. Claims 15-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO02/48202 A1.

WO-202 discloses a process for producing scratch-resistant coatings comprising a photocurable formulation. Specifically prior art process comprises preparing a

photocurable formulation comprising at least one ethylenically unsaturated compound (A), a photoinitiator of formula Ia or Ib, applying the formulation to an substrate and curing the formulation by either solely irradiation with electromagnetic radiation and/or action of heat (see abstract, pages 1-2, 16). Suitable ethylenically unsaturated component (A) can be monomeric, oligomeric and polymeric, encompassing the instant hydrophilic monomer, and the high and low molecular weight polymers (pages 16-17, 22). Prior art further suggest adding polymeric binder and polyvinylpyrrolidone dispersant aids, defined within the scope of the instant high molecular weight polymer (pages 20-21). Other conventional additives such as additional photoinitiators (i.e. benzophenones), and solvents are further disclosed (pages 30, 40, 42). Prior art specifically discloses a curing temperature ranges from room temperature to 150°C (page 44). Accordingly it would have been obvious to one having ordinary skill in the art to select a mixture of ethylenically unsaturated monomer, oligomer and polymers, a UV activable compound such as benzophenone, dispersant aids such as polyvinylpyrrolidone and an appropriate solvent to formulate a coating composition suitable for coating an implantable biomedical

device as presently claimed, motivated by the reasonable expectation of success.

Response to Arguments

Applicant's amendment and remarks filed 1/5/09 have been fully considered. In light of applicant's amendment, US 6,835,758 to Bradford et al. is hereby withdrawn as an applied reference. With respect to the Garnett reference, the crux of applicant's argument lies in prior art references does not suggest a curing step at room temperature. This is not found to be compelling for at least the following reasons. Firstly, the recited "at room temperature" does not found support in applicant's original disclosure. Secondly, Garnett et al. is not limited to curing at elevated temperature as asserted. Prior art teaches that curing at elevated temperature enhances adhesion in "some" substrates (col. 7, lines 49-60). This would implicitly suggest that not all substrates benefits from curing at elevated temperature. Thus, it would have been obvious to one skilled in the art to determine the optimum curing temperature based on the specific substrate and application. Accordingly, the examiner's position is maintained.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Helen L. Pezzuto whose telephone number is (571) 272-1108. The examiner can normally be reached on 8 AM to 4 PM, Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Helen L. Pezzuto/
Primary Examiner
Art Unit 1796